REMARKS

Claims 1-9, 11, 16, 20-22, 25-29, and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. U.S. Patent 6,522,418 and Kusama et al. U.S. Patent 6,886,131. Claims 10, 13-15, 17, 18, 23, 24, and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. U.S. Patent 6,522,418 and Kusama et al. U.S. Patent 6,886,131 as applied to claim 1 above, and further in view of Loui et al. U.S. Patent 6,813,618. Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. U.S. Patent 6,522,418 and Kusama et al. U.S. Patent 6,886,131 as applied to claim 1 above, and further in view of Taylor U.S. Patent 5,832,497. Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Yokomizo et al. U.S. Patent 6,522,418 and Kusama et al. U.S. Patent 6,886,131 as applied to claim 1 above, and further in view of Balogh et al. U.S. Patent 5,493,677.

In view of the amendment to the claims, Applicants respectfully traverse the Section 103 rejections. Yokomizo relates to a system having a remote image processing station and a server image processing station. The method has the following steps: a first storage step in which high-resolution information is stored in the remote image processing station; a first transferring step in which image information of resolution lower than that of the high-resolution image information is transferred from the remote image processing station to the server image processing station; a second storage step in which the low-resolution image information transferred in the first transferring step is stored in the server image processing station; a second transferring step in which the low-resolution image information stored in the second storage step is transferred from the server image processing station to a user's terminal; a first editing step in which the low-resolution image information transferred in the second transferring step is edited at the user's terminal; a third transferring step in which editorial information indicative of the contents of the edition performed in the first editing step is transferred from the user's terminal to the remote image processing station; and a second editing step in which the high-resolution image information stored in the first storage step is edited in the remote image processing station in accordance with the editorial information transferred in the third transferring step.

As noted in the rejection, Yokomizo does not show organizing images by associating keywords. Kusama relates to a process where binary data to which meta-data is to be appended is provided, and meta-data to be appended to the binary data are loaded. The meta-data has an XML format. The loaded meta-data is connected after the loaded binary data. The data synthesized in this manner is output as a single file as a whole.

However, Yokomizo and Kusama fail to disclose the "performing a Boolean search based on the at least one searchable keyword and wherein the one or more searchable keywords include one or more of the following: an event keyword; a people keyword; an image title keyword, an image date keyword, and a location keyword." Moreover, Yokomizo and Kusama fail to show the "generating a preview page adapted to show an image-based product incorporating a selected image processed in accordance with user-based and image-preferences."

As disclosed on page 7, lines 1-3 of the instant application: "Image preference information 306 can include preferences specific to the image content. In certain images, the user may prefer to adjust the color and tone to optimize the main subjects in the image." In certain embodiments, a preview image for an image-based product incorporating the selected image and processed in accordance with both user-based and image-preferences is displayed (block 416 shown in FIG. 4a).

There is no disclosure in Yokomizo, Kusama, Taylor, or Balogh that shows the claimed "performing a Boolean search based on the at least one searchable keyword and wherein the one or more searchable keywords include one or more of the following: an event keyword; a people keyword; an image title keyword, an image date keyword, and a location keyword" and hence claim 1 and those dependent therefrom are patentable over the references. Further, with respect to the remaining independent claims, the references do not show "generating a preview page adapted to show an image-based product incorporating a selected image processed in accordance with user-based and image-preferences." Hence, each independent claim and those dependent therefrom are patentable over the references.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189
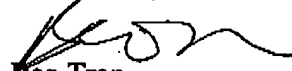
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U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails to show all claim limitations. Withdrawal of the Section 103 rejections is requested.

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,

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